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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,920	07/02/2003	Frank Scozzari		4664

7590 11/19/2004  
FRANK SCOZZARI  
1070 CLEVELAND STREET  
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EXAMINER

BASINGER, SHERMAN D

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/613,920	SCOZZARI, FRANK	
	Examiner	Art Unit	
	Sherman D. Basinger	3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 8-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Amendment*

1. The Amendments to the Figure Descriptions and specification filed October 19, 2004 were not compliant with the revised amendment practice effective July 30, 2003.
2. The Amendments to the Figure Descriptions are Amendments to the Specification and should have been included under the subtitle Amendments to the Specification.
3. It is suggested that the amendments to the figure description be included under the Amendments to the Specification and be set forth as follows.  
On page 7 of the specification after line 26 add the following brief description of figures 7 and 8:

Figure 7

A plain view of the side of a bodyboard showing how the handle assembly is attached thereto;

Figure 8

A perspective view of the top, front, side of the device, illustrating the mounting holes thereof.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not provide support for "using a standard screw driver" of claim 10. This is a new matter rejection.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Lehr et al.

Lehr et al discloses attachable handles 14 or 24 for a bodyboard wherein said handles can be fastened onto and/or easily removed from any commercial or non-commercial bodyboard using industry standard plastic leash anchors, connectors or screws.

The connectors are shown in figure 5.

The limitation "wherein said handles can be fastened onto and/or easily removed from any commercial or non-commercial bodyboard using industry standard plastic leash anchors, connectors or screws" is an intended use of the handles.

8. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 8, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehr et al in view of Gee

Lehr et al discloses attachable handles for a bodyboard, comprising:

a durable, water resistant handle 14 and an adjusting strap 24 with two mounting holes (see paragraph [0026])

desired to accommodate a leash anchor, connector (see figure 5), or screw;

said handle consisting of a one-piece nylon strap 24.

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Lehr et al does not disclose the one piece nylon strap looped and connected by a plastic buckle.

Note the nylon strap handle 30 of Gee with a plastic buckle 40D.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to provide the nylon strap 24 of Lehr et al with a plastic buckle similar to 40D of Gee. Motivation to do so is to have a buckle which allows adjustment of the strap to change the length of the strap to move handle 14 of Lehr et al closer to or farther away from the body board.

Lehr et al discloses a handled 14 attached to the top portion of the strap and two mounting holes through the bottom portion of the strap (the mounting holes receive the connectors shown in figure 5 of Lehr et al) whereby said handle can be attached to a bodyboard by inserting plastic leash anchors,

connectors or screws through the mounting holes and through the bodyboard.

The limitations that the handles are an accessory or attachment to a bodyboard and are not intended to be permanently mounted to the bodyboard, and that the handles are not incorporated or built-in to a bodyboard but instead are a resilient, separate entity from a bodyboard which can be easily added or removed from any bodyboard using standard leash anchors, connectors or screws which are commonly used in the surfing industry to attach a wrist or ankle leash to a surfboard or bodyboard are intended uses of the handle.

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11. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lehr et al and Gee as combined for claim 8 and further in view of Glydon.

Lehr et al discloses that the handles are attached to a bodyboard by a connector consisting of a male 22 and female 34 coupler. Lehr et al does not disclose that the couplers are screwed together, which enables easy removal and/or replacement of the handles from the bodyboard using a standard screw driver.

The couplers of Glydon are screwed together which enables easy removal and or replacement by using a screw driver in slot 30.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to make couplers 22 and 34 of Lehr et al screwable together for easy removal by a screw driver as taught by Glydon. Motivation to do so is to allow the couplers to be removed to replace a broken runner 16 or a broken strap 24 of Lehr et al.

### **Conclusion**

13. Applicant's amendment necessitated the new ground(s) of rejection with Lehr et al, Gee and Glydon presented in this Office action. Accordingly, **THIS ACTION IS**

**MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherman D. Basinger whose telephone number is 703-308-1139. The examiner can normally be reached on M-F (6:00-2:30 ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sherman D. Basinger  
Primary Examiner  
Art Unit 3617

sdb  
11/16/04

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